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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID FARCOT,
JEAN-FRANCOIS GONTHIER,
and HENRI RANCON

Appeal No. 2007-1463
Application No. 10/083,492
Technology Center 3600

Decided: March 19, 2008

Before WILLIAM F. PATE, III, HUBERT C. LORIN, and JENNIFER D. BAHR,
Administrative Patent Judges.

LORIN, *Administrative Patent Judge.*

DECISION ON REQUSET FOR REHEARING

INTRODUCTION

The Appellants filed a Request for Rehearing under 37 C.F.R. § 41.52 (filed Nov. 26, 2007) of the Decision on Appeal (mailed Sep. 24, 2007).

In the Decision on Appeal, the Board affirmed rejections of claims 35-37 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, and claims 1-4, 6, 7, 9, 10, 13, 16-18, 23-25, 28-30, 35-38, 40, and 41 under 35 U.S.C. § 103(a) as being unpatentable over Keller in view of Vitali and reversed rejections of claims 38, 40, and 41 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, and claims 6, 38, and 41 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention.

In the Request for Rehearing, the Appellants argued the following points:

1. on pages 5, 14, 20, 22, 23, 24, and 25 of the Decision, claim 5 is identified as being rejected even though claim 5 is not on appeal;
2. on page 26 of the Decision, the Board incorrectly stated that the Examiner's decision to reject claims 38, 40, and 41 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement is affirmed;
3. on page 8, lines 18-21, of the Decision the Board makes a sentence that "is not true" (Request 2);
4. the Appellants' arguments in the Appeal Brief in traverse of the rejection of claims 35-37 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement were misapprehended; and,
5. the Decision does not address the Appellants' separate argument in the Appeal Brief for the patentability of claims 35-37 under 35 U.S.C. § 103.

Point 1

All indications in the Decision that claim 5 is rejected are hereby withdrawn. In footnote 1 of the Decision, the Board stated that claim 5 had been indicated as containing allowable subject matter. That was an accurate statement. Indications in the Decision to the contrary were incorrect.

Point 2

The indication on page 26 of the Decision that the Examiner's decision to reject claims 38, 40, and 41 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement is affirmed is withdrawn. That indication was incorrect. The correct indication occurs at the end of the Decision on page 26 whereat the Board indicates that the Examiner's decision to reject claims 38, 40, and 41 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement is reversed. This latter indication is consistent with the analysis on pages 8 and 9 of the Decision.

Point 3

The Appellants stated that the sentence on page 8, lines 18-21, of the Decision "is not true" (Request 2). The sentence reads: "We note the use of the open-ended term "comprising" in claim 35, both in the preamble and immediately preceding the recitation of a single plate, and the absence of an express limitation excluding the presence of another such plate." We agree. This sentence appears

within a discussion of the rejection of claims 38, 40, and 41 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, and should have referred to claim 38, not 35. The sentence is a true statement with respect to claim 38, not claim 35. The sentence will not be withdrawn but modified to refer to claim 38 rather than claim 35. This modification does not materially change the Decision. The Examiner's decision to reject claims 38, 40, and 41 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, remains reversed.

Point 4

The Appellants indicated that in support of its decision to affirm the Examiner's rejection of claims 35-37 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, the Board stated:

•“We can find nothing in the claim or the specification that would convey to one of ordinary skill in the art that Appellants had possession of an assembly eliminating the presence of a second plate.” Decision 9.

•“There is nothing in the Specification that would lead one to the conclusion that a second plate existed which Appellants have necessarily omitted from the final retaining assembly.” Decision 10.

Request 4. According to the Appellants, these statements suggest that the Board misapprehended the Appellants argument in the Appeal Brief. According to the Appellants, they “did not contend that they have disclosed or claimed a second plate. To the contrary ... despite their specification having said ‘nothing about it’

(i.e., a single plate distinguished from a second plate based upon size and shape), ‘Appellants had possession of the subject matter of the rejected claims.’ And ... the subject matter of the rejected claims merely recite the retaining assembly not including a second plate having a predetermined size and shape.” Request 5.

We disagree that we misapprehended the Appellants’ argument in the Appeal Brief. We clearly understood that the Appellants were arguing that the absence of any mention of a second plate in the Specification provided written descriptive support for including in the claims the limitation that “said single plate is the only plate of the retaining assembly having said predetermined size and shape, the retaining assembly thereby *not including a second plate* having said predetermined size and shape” (claim 35). (Emphasis added). The Decision makes clear that this argument was not persuasive because claiming an assembly “not including a second plate” necessarily presumes the pre-existence of a second plate and since no such second plate, or its subsequent absence, was disclosed in the original Specification, the Specification did not convey possession of an assembly “not including a second plate.” See page 10 of the Decision:

There is nothing in the Specification that would lead one to the conclusion that a second plate existed which Appellants have necessarily omitted from the final retaining assembly. The other decisions Appellants cite (see Br. 8-11) repeat the axiom that the subject matter of a claim need not be described literally in order for the disclosure to satisfy the description requirement. They

do not support the general proposition Appellants appear to be advocating that a Specification's silence as to an element is a license to later amend the claim to describe the invention in terms of the element's absence.

Since we did not misapprehend the Appellants' argument, the Appellants' request to withdraw that portion of the Decision sustaining the rejection of claims 35-37 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, and that that rejection be reversed, on that ground, is denied.

Point 5

The Appellants argued that the Decision does not address the Appellants' discussion of claims 35-37 in the Appeal Brief as separate argument for their patentability under 35 U.S.C. § 103. Request 5-7. The Appellants appear to contend that claims 35-37 do not stand or fall with the other claims rejected under 35 U.S.C. § 103. The Appellants argued that the Appeal Brief separately argued the patentability of claims 35-37 and, under the Rules, should have been separately addressed in the Decision.

We are not persuaded that we misapprehended the Appellants' treatment of claims 35-37 in the Appeal Brief. We addressed them consistent with their treatment in the Brief. While the section dealing with claims 35-37 (see pp. 19-20 of the Appeal Brief), to which the Appellants refer, treats claims 35-37 separately, they are treated separately for claim construction purposes, not for arguing for their patentability under 35 U.S.C. § 103.

Nowhere in the Appeal Brief is there any indication that claims 35-37 do not stand or fall with the other claims rejected under 35 U.S.C. § 103.

Furthermore, the Appeal Brief clearly indicates that the purpose of separately arguing claims 35-37 was to rebut the Examiner's contention that "'dependent claims 35, 35, and 37 distinguish the single plate from additional plates based upon size and shape' and that [t]his claim differentiation suggests that 'single' is not intended to exclude the presence of additional plates.'" App. Br. 19. According to the Appeal Brief, "Appellants submit that that contention is wrong. There is an alternate reason for the wording chosen in claims 35, 36, and 37." App. Br. 20.

Furthermore, the discussion of claims 35-37 is couched within a larger claim construction discussion involving the term "single" in independent claims 1, 7, and 13 (on which claims 35-37 depend, respectively). See App. Br. 13. This is evident from the manner in which the Appeal Brief was organized. Although 37 C.F.R. § 41.68(c)(1)(vii) states that "[a]ny claim argued separately should be placed under a *subheading* identifying the claim by number," the section in the Appeal Brief dealing with claims 35-37 was placed under a *sub-sub-subheading*; i.e., "iii. Claims 35, 36, 37 Distinguishing 'Additional' Plates by Size and Shape." (App. Br. 19); that is, under the general subheading "The Rejection of Claims 1-4, 6, 7, 9, 10, 13, 16-18, 23-25, 28-30, 35-38, 40, and 41 as Being Unpatentable Under 35 U.S.C. § 103(a) Should be Reversed" (App. Br. 13) and the sub-subheading "a. A

Single Plate, and the One and Only Plate” (App. Br. 13), and after two other sub-sub-subheadings: “i. Ordinary Meaning of ‘Single’” (App. Br. 14) and “ii. Appellants’ Intent/Transitional Phrase” (App. Br. 19).

Finally, we note that the Request states that “Appellants argue in this subsection [p. 20 of the Appeal Brief] that they do intend to exclude, in claims 35, 36, and 37, the presence of additional plates and, of course, Keller fails to disclose a single plate having a predetermined size and shape.” Request 6. But we see no discussion challenging the *obviousness* of the subject matter of claims 35-37 over that of Keller. Moreover, claims 35-37 were rejected under 35 U.S.C. § 103 over Keller and Vitali, not Keller alone. Vitali is nowhere mentioned in that section of the Appeal Brief.

We are not persuaded that the patentability of claims 35-37 under § 103 was separately argued. We are not persuaded that we misapprehended the Appellants’ argument in the Appeal Brief as to claims 35-37. We were accurate in understanding that the purpose of that argument was to challenge the Examiner’s construction of the claim term “single” and to show the language in claims 35-37 supported the Appellants’ construction of that term. In light of that understanding, we properly reviewed the record and all the arguments made in the Brief, including the discussion relating to the language used in claims 35-37, to assess the merits of the contrasting views of the construction to be given the claim term “single.” The Decision (p. 18-19) addresses these differing views, reaching the conclusion that “the claimed assembly is [not] limited so as to include no more than one plate.” Decision 18.

Since we did not misapprehend the Appellants' argument, the Appellants' request to reconsider that argument and reverse the rejection of claims 35-37 under 35 U.S.C. § 103 is denied.

CONCLUSION

Appellants' arguments have been considered.

We find them persuasive as to error in the Decision indicating that claim 5 is rejected. Those indications are hereby withdrawn.

We find them persuasive as to error in the indication on page 26 of the Decision that the Examiner's decision to reject claims 38, 40, and 41 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement is affirmed. That statement is withdrawn.

We find them persuasive as to error in the sentence on page 8, lines 18-21, of the Decision: "We note the use of the open-ended term 'comprising' in claim 35, both in the preamble and immediately preceding the recitation of a single plate, and the absence of an express limitation excluding the presence of another such plate." That statement is modified to read "claim 38" instead of "claim 35."

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We do not find them persuasive as to error in affirming the rejections of claims 35-37 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, and under 35 U.S.C. § 103(a) as being unpatentable over Keller in view of Vitali.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

GRANTED-IN-PART

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